

REMARKS/ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 112 Rejections

Examiner rejected claims 1-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In particular, the examiner has stated the claimed limitation of a radio transceiver in claims 1, 7, 14, 20 and 26, is not enabled

In reply, the applicant points out the "test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

In accordance with the MPEP 2164.01(a), many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) **The breadth of the claims;**
- (B) **The nature of the invention;**
- (C) **The state of the prior art;**
- (D) **The level of one of ordinary skill;**
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407; MPEP 2164.01(a).

A conclusion of lack of enablement means that, based on the evidence **regarding each of the above factors**, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. (*In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); MPEP 2164.01(a)).

The determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations. (MPEP 2164.01(a)).

In the present matter, the examiner has stated the claimed limitation of a radio transceiver is not enabled by the description. Applicant disagrees.

When considering the claimed limitation of a radio transceiver in view of the factors to be considered when determining enablement, clearly the claimed radio transceiver is enabled. Specifically, "the state of the prior art", as well as "the level of one ordinary skill" at the time of filing the application, indisputably included radio transceivers. At the time of filing the application, radio transceivers had been around for decades. Therefore, at the time of filing the application, "there was clearly a high level of skill" in radio transceivers, as well as "the method needed to practice" radio transceivers were very well known. *In re Wands*, 858 F.2d 731, 740 (Fed. Cir. 1988).

A patent need not teach, **and preferably omits, what is well known in the arts.** *In re Buchneer*, 929 F.2d 660, 661 (Fed.Cir. 1991). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art.

Therefore, applicant submits that all claims, in particular the claim limitation of a radio transceiver, are clearly enabled in accordance with the governing rules.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

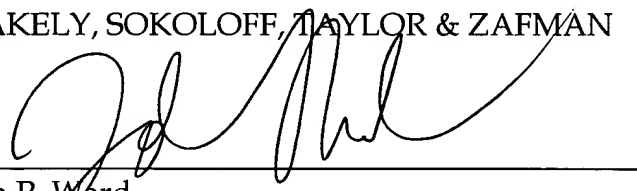
Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: _____

3/24/04



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